

Remarks:

Applicant has carefully studied the non-final Examiner's Action mailed 10/18/2004, having a shortened statutory period for response set to expire 01/18/2005, and all references cited therein. The amendment appearing above and these explanatory remarks are believed to be fully responsive to the Action. Accordingly, this important patent application is now believed to be in condition for allowance.

Applicant responds to the outstanding Action by centered headings and numbered paragraphs that correspond to the centered headings and paragraph numbering employed by the Office, to ensure full response on the merits to each finding of the Office.

Claim Rejections – 35 U.S.C. § 112

Applicant acknowledges the quotation of 35 U.S.C. § 112, second paragraph.

Claim 15 stands rejected under 35 U.S.C. § 112, second paragraph, because said claim 15 depends from cancelled claim 1. This rejection is met by amending claim 15 so that it depends from claim 14.

Claim Rejections – 35 U.S.C. § 103

Applicant acknowledges the quotation of 35 U.S.C. § 103(a).

1. Claims 14 and 16 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Marier, Jr. in view of Wateska et al. (hereinafter "Wateska"). Reconsideration and withdrawal of this ground of rejection is requested for the following reasons.

The Office contends: "Though Marier, Jr. prefers the elevated path guide means to extend in two directions, (it) would achieve the same result with one rod extending in one direction and would be obvious to omitted (*sic*) a rod in order to reduce the arc swing zone of the user."

This contention of the Office is respectfully traversed because both rods are required in the Marier, Jr. construction. If the arc swing zone of the user is reduced by being cut in half, then Marier, Jr. provides no path guidance means. The Marier, Jr. device lacks utility if the leading end of rod assembly 12 is removed or if the trailing end of the rod is removed. Fig. 1 indicates that both rods 22, 22 must be used at the same time and Figs. 2 and 3 indicate that rod assembly 12 must be engaged at its mid-point by T-joint 24.

The teaching of a single rod positioned either on the leading or the trailing side of a T-joint, but not on both sides at the same time, is Applicant's teaching. The Office's contention that the Marier, Jr. construction "would achieve the same result with one rod extending in one

direction and would be obvious to omitted a rod in order to reduce the arc swing zone of the user..." should be reconsidered and withdrawn to avoid unfairness to Applicant.

In re Larson, 340 F.2d 965, 144 USPQ 347 (CCPA 1965) held that omission of parts such as an additional framework or an axle would have been obvious because such omission increased the cargo carrying capacity of a mobile fluid carrying unit. Consistently, *In re Kuhle*, 526 F.2d 553, 188 USPQ 7 (CCPA 1975), held that it would have been obvious to delete a prior art switch, thereby eliminating its function.

The rationale behind *Larson* and *Kuhle* is that deletion of a part is not an inventive step if the purpose behind the deletion is merely to omit a function. For example, a bicycle without brakes does not represent an improvement over a bicycle with brakes. However, Applicant has not merely deleted one of the Marier, Jr. rods 22 to eliminate one of the functions of the Marier, Jr. device. To the contrary, Applicant has added a support rod that is selectively placed either in leading or trailing relation to the cradle interface. Marier, Jr., provides no rod that can be positioned either in leading or trailing relation to T-joint 24. The Marier, Jr. rods 22, 22 can only be placed on opposite sides of T-joint 24 at the same time.

In *Larson*, elimination of the extra framework or the axle did not destroy the function of the mobile fluid carrying unit. In *Kuhle*, elimination of an unneeded switch actuator did not destroy the function of the device. In both cases, the purported improvement was a mere deletion of an unnecessary part.

Applicant, on the other hand, has disclosed a structure patentably distinct from the structure of Marier, Jr. Deletion of an unneeded, superfluous part of the Marier, Jr. structure does not produce the structure recited in Applicant's claim 1 as currently amended. Both rods 22, 22 are absolutely required by Marier, Jr. Deletion of either rod 22, 22 destroys the utility of the Marier, Jr. structure. Neither rod 22, 22 can be characterized as a superfluous, unneeded part like the axle in *Larson* or the switch actuator in *Kuhle*.

Accordingly, neither *Larson* nor *Kuhle* apply to the facts of the present case. Applicant has not merely deleted a part or parts from Marier, Jr. to omit a function that is not needed. Applicant has clearly not deleted rod assembly 12 which is formed of rods 22,22.

Omission of either rod 22, 22 renders the Marier, Jr. device non-functional. It would not have been obvious to modify the Marier, Jr. structure to remove all of its functionality.

Larson and *Kuhle* would apply if Applicant had deleted, for example, either one of tubing members 52, 52, because such omission would not affect the operability of the Marier, Jr. device. Both items of tubing 52, 52 could be deleted without affecting the utility of the Marier, Jr. device. However, deletion of either rod 22, 22 is an entirely different matter and does not fall under the *Larson* and *Kuhle* line of cases. Rods 22, 22, as Marier, Jr. points out at col. 2, lines 56-59, can be replaced by a continuous shaft. Therefore, it would not have been obvious to omit either one of them because to do so prevents said rods or continuous shaft from providing the path guidance means of the Marier, Jr. invention.

Marier, Jr., obviously neither teaches nor suggests that rod assembly 12 could be reduced to only one rod 22, or that rod assembly 12 can be mounted entirely on the leading side of T-joint 24 or entirely on the trailing side of said T-joint.

As currently amended, claim 14 now further points out that Applicant's support rod is selectively and manually positionable in either leading or trailing relation to the cradle interface. This emphasizes the point that the Marier, Jr. rods 22,22 cannot be positioned in leading or trailing relation to T-joint 24. To function, the Marier, Jr. rods 22,22 must be positioned simultaneously in leading and trailing relation to T-joint 24.

Rods 22,22 would no longer provide a path guidance means if either one of them were deleted from the Marier, Jr., construction. Both *Larson* and *Kuhle* hold that eliminating a non-critical part from Marier, Jr. would have been an obvious expedient not rising to the level of a patentable improvement. Applicant did not merely delete a non-critical part to eliminate a superfluous function. Applicant provided a training device having only one removable part and the device is re-configurable to match the skill level of the user as is now claimed with increased specificity in claim 14, currently amended. Marier, Jr. is not re-configurable at all and cannot be adapted to players of differing skill levels. Any modification of Marier, Jr. to make it re-configurable for players of differing skill levels would derive from Applicant, and not the other way around. Applicant is therefore entitled to the *quid pro quo* promised those who advance the useful arts.

Applicant concedes that Wateska teaches the use of cushioning material in a golf swing training device but Marier, Jr., modified by Wateska, does not suggest the invention recited in claim 14, as currently amended.

2. Claims 15 and 17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the prior art as applied to claim 14, and in view of Macri. Applicant acknowledges that Macri and the admitted prior art would have suggested the respective subjects matter of claims 15 and 17. Applicant relies upon the dependency of claims 15 and 17 from claim 14 as currently amended to support their allowance. Neither Macri nor the admitted prior art would have taught or suggested the invention claimed in claim 14, as currently amended.

3. Claim 18 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over the prior art as applied to claim 14, in view of McCormick. Applicant acknowledges that McCormick and the admitted prior art would have suggested the subject matter of claim 18. Applicant relies upon the dependency of claim 18 from claim 14 as currently amended to support its allowance. Neither McCormick nor the admitted prior art would have taught or suggested the invention claimed in claim 14, as currently amended.

4. Claims 19 and 20 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over the prior art as applied to claim 14 and in view of admitted prior art. Applicant acknowledges that the admitted prior art would have suggested the respective subjects matter of claims 19 and 20. Applicant relies upon the dependency of claims 19 and 20 from claim 14 as currently amended to support their allowance. The admitted prior art would not have taught or suggested the invention claimed in claim 14, as currently amended.

5. Claim 21 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over the prior art as applied to claim 20, further in view of Lambert. Applicant acknowledges that Lambert and the admitted prior art would have suggested the subject matter of claim 21. Applicant relies upon the dependency of claim 21 from claim 14 as currently amended to support its allowance. Neither Lambert nor the admitted prior art would have taught or suggested the invention claimed in claim 14, as currently amended.

Response to Arguments

Applicant thanks the Office for its consideration of the arguments made in Amendment E, and for the additional consideration given to the arguments advanced in this Amendment F.

In view of the allowability of claim 14 and its dependent claims, Applicant has elected against filing a Notice of Appeal.

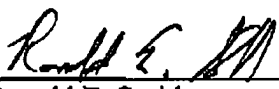
Conclusion

If the Office is not fully persuaded as to the merits of Applicant's position, or if an Examiner's Amendment would place the pending claims in condition for allowance, a telephone call to the undersigned at (727) 507-8558 is requested.

Very respectfully,

SMITH & HOPEN

Dated: December 21, 2004

By: 
Ronald E. Smith
Suite 220
15950 Bay Vista Drive
Clearwater, FL 33760
(727) 507-8558
Attorneys for Applicant

pc: Mr. Jim Sowerwine

CERTIFICATE OF FACSIMILE TRANSMISSION
(37 C.F.R. 1.8(a))

I HEREBY CERTIFY that this Amendment F, including Introductory Comments, Amendments to the Claims, and Remarks, is being transmitted by facsimile to the United States Patent and Trademark Office, Art Unit 3711, Attn: Mr. Alvin A. Hunter, (703) 872-9302 on December 21, 2004.

Dated: December 21, 2004


Shelley Butz